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MAIL STOP
APPEAL BRIEF - PATENTS
PATENT
21591

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Stephen P. CRAIG Conf. No. 5281
App. No.: 10/649,614 Group: 3644
Filed: August 28, 2003 Examiner: Susan C. Alimenti
For: BARRIER ARRANGEMENT FOR PLANTS

APPEAL BRIEF

**MAIL STOP APPEAL
BRIEF - PATENTS**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTION

Pursuant to 37 C.F.R. § 1.192, this Appeal Brief is filed in support of the Notice of Appeal to the Board of Patent Appeals and Interferences dated October 20, 2004, appealing the rejection of the claims as set forth in the Final Office Action of July 27, 2004, as modified in the Advisory Action dated October 7, 2004.

REAL PARTY IN INTEREST

The real party interest is Stephen P. Craig, the inventor named in the application.

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RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellant or the appellant's legal representative which will directly affect or be directly affected by or having a bearing on the Board's Decision in the pending appeal. It is also noted that this application is not assigned, but remains the sole property of the inventor.

STATUS OF CLAIMS

Claims 1-8, 13-17 and 19 are the claims on appeal, while claims 9-12 and 18 were merely objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has deferred rewriting certain claims in independent form pending the outcome of this appeal because allowance of the improperly rejected parent claims 1 and 15 would obviate the need for rewriting additional independent claims.

Summarizing the status of the claims, claims 1-8, 13-17 and 19 stand presently rejected under 35 U.S.C. § 103 as unpatentable over the U.S. Glassman Patent 3,766,667 (the '667 Patent), while the rejection under 35 U.S.C. § 112, second paragraph, of claim 19 has been withdrawn in view of the arguments presented in the Amendment Under 37 C.F.R. § 1.116 dated September 29, 2004. Additionally, the amendments to claims 11, 18 and 19 in line with the Examiner's suggested preferred language has been entered, as indicated in the

Advisory Action dated October 7, 2004. A correct copy of the appealed claims 1-8, 13-17 and 19 as presently on file is set forth in the attached Appendix A - The Claims On Appeal.

STATUS OF AMENDMENTS

As mentioned under **STATUS OF CLAIMS**, claims 11 and 19 were amended in the Amendment Under 37 C.F.R. § 1.116 to change the language to the preferred suggested language of the Examiner, and these amendments have been entered pursuant to the Advisory Action of October 7, 2004.

SUMMARY OF INVENTION

The invention defined in the claims involved in the appeal relates to a protective barrier arrangement to be placed between a plant pot and the supporting surface, such as a floor or carpet on which the pot is normally placed. The resulting stains on the floor or on the carpet are a common experience, especially if the pots are made from terra cotta or similar materials (parenthetical reference is to the original specification, page 1, lines 8-17). Additionally, any barrier placed between the plant pot and the supporting surface normally experiences soiling that cannot be easily removed. Furthermore, the large number of different sizes of pots makes it desirable that the protective barrier arrangement can be matched at least approximately to the size of the plant pot.

To achieve all of these goals, the protective barrier arrangement defined by the claims involved in this appeal is made of a number of slat-

like members generally designated by reference numeral (10) of predetermined length, width and height, whereby each slat-like member (10) is provided on one side (10a) thereof with a number of pegs (11) circular in cross section that are adapted to engage in a corresponding number of holes of complementary dimension aligned with the pegs and extending inwardly from the other side of the slat-like member (10) (page 3, lines 1-9).

To protect and conceal the pegs of the last lateral slat-like support member (10), each slat-like member is also provided with a number of additional holes (13) that are similarly arranged as the holes (12), though located on the one side (10a) of the slat-like member and symmetrically arranged with respect to the center transverse plane (x-x) of a given slat-like member. These holes (13) serve an important function, that is, to protect and conceal the pegs (11) of the last lateral slat-like member. This feature is illustrated in Figure 1 in which the left-most slat-like member (10) has been rotated through 180° in order to protect and conceal the pegs (11) of the middle slat-like member (10). With the left slat-like member (11) rotated through 180° and engaging in holes 13 of the middle slat-like member (10), neither the left slat-like member (10), nor the right slat-like member (10) have any exposed pegs (11) that would be likely to be broken off in normal use, for example, if someone hits the protective barrier arrangement (column 3, lines 9-22).

The protective barrier arrangement of this invention can thus be readily assembled, disassembled for thorough cleaning and re-assembled after cleaning to its intended size. Utilizing injection-molded plastic parts permits the slat-like members to be thoroughly washed in a dishwasher so that the slat-like members will be completely clean and so that the slat-like members can be reassembled for further use (page 3, line 23 through page 4, line 3).

An additional feature of this invention is the use of a moisture-retaining channel (15) to retain moisture (water) that may permeate through the bottom of the pot and also through the bottom of any saucer on which the pot is placed (page 4, lines 4-13). The channel (15) extends over at least a major part of the length of each slat-like member, preferably over the entire length thereof and is thereby closed at both ends thereof, but may also be open at least at one end thereof, especially if the channel slants downwardly. Preferably the downward slant is slight so that the moisture primarily stays in the channel and does not spill over or empty out until the level is above the closed end at the lower end of the channel. The channel may also be provided with a very small hole, especially at the lower end, if slanted, to permit a slight drainage (page 4, lines 13-24). The advantages of the protective barrier arrangement defined by the claims involved in this appeal are set forth on page 4, line 23 through page 5, line 5. These advantages will be

stressed hereinafter in the discussion of the shortcomings of the applied reference.

REFERENCE RELIED UPON

The sole reference relied upon is the

U.S. Patent 3,766,667 to Glassman.

ISSUES ON APPEAL

The sole issue presented for review is the issue of obviousness of the rejected claims under 35 U.S.C. § 103 over the single patent relied upon by the Examiner which is

the U.S. Patent 3,766,667 to Glassman.

Thus, the sole issue is whether claims 1-8, 13-17 and 19 are unpatentable under 35 U.S.C. § 103 over Glassman.

GROUPING OF CLAIMS

Applicant respectfully submits that the claims involved in the rejection under 35 U.S.C. § 103 do not stand or fall together but rather are believed to be separately patentable for reasons that will be pointed out in detail in the arguments, discussing the inadequacies of these rejections and pointing out how the claims patentably differ from one another.

ARGUMENTS

After four (4) years as an Examiner in the PTO and during more than fifty (50) years in private practice, the undersigned has rarely seen a rejection based on prior art which is as far removed from the invention defined by the claims on Appeal as is the case in connection with the present application.

The single reference relied upon in the rejection of the claims not only is non-analogous art, but also does not address and does not deal with the problems only the present invention solves, and is totally devoid of any suggestion of the invention.

More specifically, the U.S. Patent 3,766,667 to Glassman (the '667 Patent) relates to an educational toy useful as an aid in teaching arithmetic concepts. To that end, it proposes a number of blocks of specified length with a corresponding number of holes, all relating to a fixed number. As shown in Figure 1, ten blocks identified as blocks B-1, B-2, etc., with a length accommodating 1, 2, 3, etc. holes (30) are provided to permit the child to stack the same in order to get some arithmetic concepts.

Applicant's invention is not directed simply to stacking of blocks by means of pegs, as is suggested by the rejection, but is directed to the achievement of specific goals in connection with protective barriers to be interposed between the pot for a plant and the floor or carpet on which the pot is supported. This invention is predicated on solving

simultaneously several problems which are peculiar to the kind of protective barrier arrangement to which the present invention relates.

The features which are attained by the present invention are as follows:

1. Simple assembly and disassembly of the protective barrier arrangement;
2. Protection against damage to the pegs used for the connection of the various slat-like members;
3. Possibility of removing the usually hard-to-remove dirt from the slat-like members by washing the same, for example, in a dishwasher;
4. Selectively changing the size of the protective barrier arrangement.

These features are attained according to the present invention in the following manner:

1. Individual slat-like members are used that can be easily assembled and disassembled;
2. Protection for the pegs in the last lateral slat-like member is achieved by providing a similarly arranged number of holes on the same side of the slat-like member on which are arranged the pegs but disposed substantially symmetrically with respect to the transverse center plane of a given slat-like member which then permits rotation of each last lateral slat-like member to conceal and protect the pegs thereof.

3. Rather than utilizing wood for the material of the slat-like members, which would preclude use of a dishwasher to clean the slat-like members, the slat-like members are made of plastic material.

4. By simply changing the number of slat-like members, the size of the protective barrier arrangement can be varied.

Claim 1 clearly contains all of the limitations to achieve these features.

Features 1. and 4. are specified in claim 1 on appeal by calling for

"a protective barrier arrangement to be placed between a plant pot and the supporting surface which is adapted to be assembled into predetermined configuration depending on the size of the pot, comprising a plurality of plastic slat-like members of given height, width and length, each provided with assembling means for assembling the slat-like members in predetermined configuration, including a number of pegs and holes..."

Feature 2. is achieved by the recitation of

"a further number of similarly arranged holes is provided on said one side which are disposed substantially symmetrically with respect to the transverse center plane of the slat-like member to permit rotation of each last lateral slat-like member to conceal and protect the pegs thereof."

Feature 3. is achieved by specifying that the slat-like members are **plastic** slat-like members.

In addition to the aforementioned features, some of the dependent claims provide additional features dealing with possible drainage of moisture (water) that may seep through the pot or the saucer on which the pot is placed, as will be discussed more fully hereinafter.

With respect to the limitation that applicant's slat-like members are made from plastic material, the Examiner in the second paragraph of 6. of the Final Rejection dated July 27, 2004, admitted that Glassman does not specify what type of material is used for the block members and pegs, but contended in 8. of the Final Office Action that it would have been obvious to one having ordinary skill in the art to make Glassman's device of plastic material, further arguing that it is within the general skill of a person skilled in the art "to select a known material on the basis of its suitability for the intended use." This position is flawed both factually and legally. On the one hand, cost-effectiveness would surely suggest the use of wood for the material of the '667 Glassman Patent because a different mold would have to be made for each different size of the block. Secondly, there is no compelling reason to make the parts of the '667 Patent of plastic material, whereas plastic material is essential for the protective barrier arrangement of this invention to permit the type of cleaning off dirt difficult to remove in the assembled condition, as envisaged only by the present invention.

The '667 Patent totally fails to address the feature 2. of protecting exposed pegs against damage such as breakage. In fact, the structure of the '667 Patent explicitly teaches against this feature by insisting, for example, in describing Figures 6 and 7 that the pegs (12) be exposed (column 4, lines 14-22 of the '667 Patent). In fact, the Examiner does not realistically address the limitations in the last five lines of claim 1,

specifying "wherein a further number of similarly arranged holes is provided...to conceal and protect the pegs thereof." Instead, in 6., second paragraph, of the Final Office Action, the Examiner seeks to justify the rejection in the following inappropriate manner.

"...member B-6 has six holes wherein three pegs could be inserted into three of said holes while the symmetrically opposite holes are left void."

Apart from making no sense at all, this type of rationalization is at best a hindsight approach to find a basis for the rejection which, in fact, is non-existent. The issue is not what might be done with a given structure, based solely on wishful hindsight considerations to support an unwarranted ejection, but what does the patentee disclose as to the use of the structure. Moreover, the Examiner's position does not justify the ultimate conclusion of obviousness because the '667 Patent neither deals with the problem of protecting the pegs nor provides the slightest suggestion of how this can be accomplished. In fact, the '667 Patent places a high degree of importance on the length of the pegs to achieve the educational purpose of Glassman's toy (see, for example, column 3, lines 7-62; column 4, lines 14-22; column 5, lines 5-20; column 5, lines 48-56; and especially also column 6, lines 30-42).

To adopt the Examiner's position would be to obliterate the very purpose of the '667 Patent, found in column 7, lines 9 et seq. which states

"It will be found that an **important** consideration in constructing devices in accordance with the present invention will be to construct the pegs 12 with a length dimension p which is a **nonintegral** multiple of the height h of the blocks B in order to provide for the ability to construct a multiplicity of stacked levels of blocks B with a continuous portion of the peg length extending between stacked block levels." (emphasis added)

Applicant respectfully submits that the contention of obviousness of claim 1 over the '667 Patent is simply without any merit whatsoever because it is contrary to the facts and law applicable to the issue of obviousness.

Claim 2 adds the further patentable limitation to claim 1 that the slat-like members are injection-molded parts. This not only confirms the plastic nature of the slat-like members, but also spells out the feature of cost-effectiveness of the invention.

Claim 3 adds the patentable limitation to claim 1 of the

"moisture-retaining means in the top surface of the slat-like member."

The purpose of the moisture-retaining means is to avoid the possibility that moisture (water) may seep through the bottom of the pot or saucer and will spill over onto the floor or carpet. The Examiner's explanation of obviousness is found in the following incongruous statement

"...when Glassman's device is oriented as seen in Figure 8, the moisture-retaining means is defined as the indentation created by the combination of hole 30 and peg 12 (Glassman Figure 8)."

Applicant respectfully submits that this reasoning is so patently untenable as not to warrant any further comment. However, suffice it to point out that it also fails to follow the mandated interpretation under 35 U.S.C. § 112, paragraph 6, in connection with means-plus-function clauses.

Claim 4 adds the further specific limitation to claim 3 that the "moisture-retaining means is in the form of a depression in the top of the slat-like member." Again, claim 4 thus adds further patentable limitations to claim 3 from which it is dependent. With respect to claim 4, the Examiner conveniently stated

"...said indentation is in the form of a depression, slanted downwardly and extends over at least a substantial part of the length of said slat-like member."

Applicant has found no basis for this contention, nor does it make any sense insofar as the '667 Patent is concerned.

Claim 5 further adds the patentable limitation to claim 4 that the depression "is substantially symmetrically shaped."

No particular passage in the Final Office Action, however, deals with this limitation except what was indicated already above.

Claims 6 and 7 relate to different species by specifying the shape of the depression, resembling a triangle in claim 6, and having a curvilinear shape in claim 7. Again, it is not seen how even the distorted interpretation of the '667 Patent can be construed to meet these limitations.

Claim 8 adds the patentable limitation to claim 4 that the depression "extends over at least a substantial part of the length of a slat-like member."

Again, it is not seen how this limitation can be found in the '667 Patent, even accepting, ***arguendo***, the Examiner's implausible interpretation of the reference.

Claim 13 adds the patentable limitation to claim 1 that the number of pegs and similarly arranged holes is at least two (2). This limitation is significant in the context of the present invention because if only two (2) pegs are used, the loss of one peg would lead to instability of the arrangement, thereby giving greater emphasis to the protective arrangement for the pegs.

What was said with respect to claim 13 is equally applicable to claim 14.

Claim 15 is similar to claim 1 but contains the further patentably distinguishing limitation that

"the exposed ends of the pegs have a length smaller than the width of a given slat-like member..."

This limitations adds patentability to the subject matter of claim 1 because it would defeat the purpose of the present invention if the exposed ends of the pegs had a length greater than the width of a given slat-like member. Moreover, this limitation further distinguishes the claim over the '667 Patent in which the length *p* of pegs 12 is critical, as pointed out above, and is intentionally made larger than the thickness of a block.

Claim 16 adds the further patentably distinguishing limitation that

"the depth of the holes in a given slat-like member is smaller

than the width of the slat-like member."

This limitation further distinguishes over the '667 Patent in which the holes must extend clear through the entire height of the block in order to achieve the intended purpose.

Claim 17 adds the further patentable limitation to claim 15 of the "moisture-retaining means in the top surface of the slat-like member..."

The rejection of claim 17 is legally and factually flawed for reasons pointed out above in connection with the discussion of the improper rejection of claims 3 and 4.

Claim 19 adds to claim 1 the limitation concerning the exposed length of the pegs being smaller than the width of a given slat-like member.

Patentability is clearly warranted for reasons pointed out in connection with claim 15.

A serious effort has been made to point out the non-obviousness of the claims of the present application over the '667 Patent. As should be apparent from the discussions above, applicant does not claim the simple assembly of slat-like members by pegs and holes, but provides a protective barrier arrangement that exhibits a number of features that are highly desirable, if not essential, for its intended purpose.

Additionally, while the present invention may appear simple, simplicity is no bar to the patentability of an improvement unless it can

be shown that such improvement was either anticipated in the prior art or rendered obvious by the prior art.

CONCLUSION

Applicant respectfully submits that the rejection of claims 1-8, 13-17 and 19 as obvious under 35 U.S.C. § 103 over the '667 Patent is contrary to applicable law, taking into consideration the uncontroverted factual distinctions presented by the claims involved on appeal as compared to the teachings of the '667 Patent disclosure.

Accordingly, it is respectfully requested that the rejections of claims 1-8, 13-17 and 19 be reversed and that these claims be indicated allowable.

The prescribed fee for the Appeal Brief in the amount of \$170.00, applicant claiming small entity status, is attached hereto. However, it is respectfully requested that any shortage of fees be charged to the Deposit Account of Paul M. Craig, Jr., Account No. 03-3560.

Applicant also hereby repeats the request for an oral hearing already set forth in the request of October 20, 2004, which contained the necessary fee for such hearing.

Respectfully submitted,



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Attachments - Appendix A
\$170.00 Check

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APPENDIX A - THE CLAIMS ON APPEAL

1. A protective barrier arrangement to be placed between a plant pot and the supporting surface which is adapted to be assembled into predetermined configuration depending on the size of the pot, comprising a plurality of plastic slat-like members of given height, width and length, each provided with assembling means for assembling the slat-like members in predetermined configuration, including a number of pegs and holes, whereby the number of pegs on one side of a slat-like member corresponds to a similarly arranged number of holes on the other side of the slat-like member, and wherein a further number of similarly arranged holes is provided on said one side which are disposed substantially symmetrically with respect to the transverse center plane of the slat-like member to permit rotation of each last lateral slat-like member to conceal and protect the pegs thereof.

2. A protective barrier arrangement according to claim 1, wherein said slat-like members are injection-molded parts.

3. A protective barrier arrangement according to claim 1, further comprising moisture-retaining means in the top surface of the slat-like member.

4. A protective barrier arrangement according to claim 3, wherein said moisture-retaining means is in the form of a depression in the top surface of the slat-like member.

5. A protective barrier arrangement according to claim 4, wherein said depression is substantially symmetrically shaped.

6. A protective barrier arrangement according to claim 4, wherein said depression has a shape resembling a triangle.

7. A protective barrier arrangement according to claim 4, wherein said depression has a curvilinear shape.

8. A protective barrier arrangement according to claim 4, wherein said depression extends over at least a substantial part of the length of a slat-like member.

* * * * *

13. A protective barrier arrangement according to claim 1, wherein the number of pegs and similarly arranged holes is at least two.

14. A protective barrier arrangement according to claim 1, wherein the number of pegs and similarly arranged holes is three.

15. A protective barrier arrangement to be placed between a plant pot and the supporting surface which is adapted to be assembled into predetermined configuration depending on the size of the pot, comprising a plurality of plastic slat-like members having a top surface, a bottom surface and two side surfaces of given height, width and length, each provided with assembling means at the side surfaces for assembling the slat-like members in predetermined configuration, including a number of pegs and holes, whereby the exposed ends of the pegs have a length smaller than the width of a given slat-like member and whereby the number of pegs on one side of a slat-like member corresponds to a similarly arranged number of holes on the other side of the slat-like member, and wherein a further number of similarly arranged holes is provided on said one side which are disposed substantially symmetrically

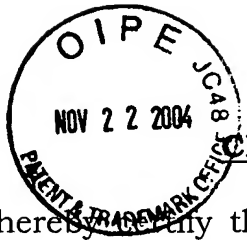
with respect to the transverse center plane of the slat-like member to permit rotation of each last lateral slat-like member to conceal and protect the pegs thereof.

16. A protective barrier arrangement according to claim 15, wherein the depth of the holes in a given slat-like member is smaller than the width of the slat-like member.

17. A protective barrier arrangement according to claim 15, further comprising moisture-retaining means in the top surface of the slat-like member and wherein said moisture-retaining means is in the form of a depression in the top surface of the slat-like member.

* * * * *

19. A protective barrier arrangement according to claim 1, wherein said pegs are of such length that the exposed length thereof is smaller than the width of a given slat-like member.



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service, as First Class Mail, postage prepaid, in an envelope addressed to **MAIL STOP APPEAL BRIEF - PATENTS**, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450, on November 19, 2004.



Paul M. Craig, Jr.